United States. Circuit Court. District of Connecticut.

In Equity, No. 1141 on Patent No. 683,615

NATIONAL PHONOGRAPH COMPANY, Complainant

against

AMERICAN GRAPHOPHONE COMPANY, Defendant.

RECORD, 1903 - 1905.

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No 11441 Recorded Vol 21 p 447

UNITED STATES CIRCUIT COURT,

DISTRICT OF CONNECTICUT.

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NATIONAL PHONOGRAPH COMPANY,

Complainant,

against

AMERICAN GRAPHOPHONE COMPANY,

Defendant.

---

BILL OF COMPLAINT.

Pat 683.615

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RICHARD N. DYER,
Solicitor for Complainant,
No. 31 Nassau Street,
Borough of Manhattan,
New York City.

Filed Oct 24, 1903
E. Callahan
Clerk

Discontinued without
prejudice at costs
June 26. 1905
E. Callahan Clerk

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TO THE HONORABLE, THE JUDGES OF THE UNITED STATES CIRCUIT COURT FOR THE DISTRICT OF CONNECTICUT:-

The NATIONAL PHONOGRAPH COMPANY, a corporation organized and existing under and by virtue of the laws of the State of New Jersey and having its principal place of business at Orange in the County of Essex and State of New Jersey, brings this, its bill of complaint, against AMERICAN GRAPHOPHONE COMPANY, a corporation organized and existing under the laws of the State of West Virginia and having a regular and established place of business in the City of Bridgeport and State of Connecticut in said District.

And thereupon your orator complains and says:-

I.- That heretofore and before the 31st day of July, 1900, Walter Henry Miller and Jonas Walter Aylsworth, being then as now residents of Orange and East Orange, respectively, in the County of Essex and State of New Jersey, and both citizens of said State, were the original, first and joint inventors of a certain new and useful improved method of duplicating phonographic records, not known or used by others in this country before their invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before their invention or discovery thereof, or more than two years prior to their application for a patent therefor in this country as hereinafter set forth, and not in public use or on sale in this country for more than two years prior to their said application, and which had not been abandoned; and which invention or improvement

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was not first patented or caused to be patented by the said inventors or their legal representatives or assigns in a foreign country upon an application filed more than seven months prior to the filing of the said application in this country.

II.- That the said Miller and Aylsworth, being as aforesaid the first inventors and discoverers of the said improvement, jointly made application in writing to the Commissioner of Patents of the United States for the grant of Letters Patent therefor, and paid into the Treasury of the United States the fees required by law, and then and there fully and in all respects complied with all the necessary conditions and requirements of the statutes of the United States in such case made and provided, and by a proper instrument in writing, duly executed and delivered, and duly recorded in the Patent Office, sold and assigned to your orator, National Phonograph Company, the full and entire right, title and interest in and to the said invention and application and the Letters Patent to be granted in pursuance of said application, and requested the Commissioner of Patents to issue the said patent to your orator as their assignee, and thereupon, after due examination having been made by the Commissioner of Patents as to the novelty and utility of the said invention as provided by law, the Commissioner of Patents caused to be issued to your orator, National Phonograph Company, Letters Patent in due form of law, under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and bearing date the 1st day of October, 1901, and numbered 683,615; and that the said Letters Patent

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did grant unto your orator and unto its successors or assigns, for the term of seventeen years from the date thereof, the exclusive right to make, use and vend the said invention throughout the United States and the Territories thereof, as by said Letters Patent or a duly authenticated copy thereof in court to be produced will more fully and at large appear.

III.- That your orator is engaged in the manufacture of phonographic records produced by the employment of said improvement or invention, and has so manufactured and sold large quantities of such phonographic records, and has invested and expended large sums of money and has been put to great trouble in and about the said invention for the purpose of introducing the same and making the same profitable to your orator and to the public; and your orator believes that it will realize and receive large gains and profits therefrom if infringement by the said defendant and its confederates be prevented.

IV.- That the said defendant, well knowing the premises and the rights secured to your orator as aforesaid, but contriving to injure it and to deprive it of the benefits and advantages which might and otherwise would accrue unto it from the said invention, did, after the grant of said Letters Patent and before the commencement of this suit, as your orator is informed and believes, within the District of Connecticut aforesaid and elsewhere in the United States, without license or allowance and against the will of your orator and in violation of its rights, unlawfully and wrongfully make, or cause to

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be made, and is now making, or causing to be made, phonographic records by the employment of the said improved method of duplicating phonographic records employing and containing the invention set forth in the Letters Patent aforesaid, and did use or cause to be used, as aforesaid, the said invention in the manufacture of said phonographic records; and that it still continues so to do, and that it threatens to continue the aforesaid unlawful acts to a large extent, all in defiance of the rights secured to your orator as aforesaid, and to its great and irreparable loss and injury, and by which your orator has been and still is being deprived of great gains and profits which it might and otherwise would have obtained, but which have been received and enjoyed by the said defendant through its said unlawful acts and doings. And your orator further shows that as to how many phonographic records the defendant has as aforesaid unlawfully made, and as to the extent of the gains and profits received and enjoyed by it from such unlawful making, your orator is ignorant and prays a discovery thereof.

V.- That the manufacture of phonographic records by the employment of the invention set forth in the Letters Patent aforesaid by the defendant, and its preparation for and avowed determination to continue the same in disregard and defiance of the rights of your orator, have the effect to encourage and induce others to venture to infringe said Letters Patent.

VI.- Your orator therefore prays that the said defendant, American Graphophone Company, and its officers, servants, agents, attorneys, employees, workmen and confederates, and each and every of them, may be perpetually

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restrained and enjoined, by the order and injunction of this Honorable Court, from directly or indirectly making phonographic records by the employment of the invention of the Letters Patent aforesaid, and that they, and each and every of them, be ordered to deliver to your orator or to an officer of this Court for destruction all molds and other apparatus used by the said defendant in the carrying on of said method covered by the Letters Patent aforesaid, and that the said defendant may be decreed to pay the costs of this suit, and that your orator may have such other and further relief as to this Honorable Court shall seem meet and as shall be agreeable to equity.

VII.- Your orator further prays that an injunction pendente lite be granted, issuing out of and under the seal of this Honorable Court, enjoining and restraining the said defendant and its officers, servants, agents, attorneys, employees, workmen and confederates, and each and every of them, to the same purport, tenor and effect as hereinbefore prayed for with regard to said perpetual injunction.

VIII.- And forasmuch as your orator can have no adequate relief save in this Court, to the end therefore that the said defendant may, if it can, show why your orator should not have the relief hereby prayed, and may, but not upon oath, an answer under oath being hereby expressly waived, according to the best and utmost knowledge, remembrance, information and belief of its officers, full, true, direct and perfect answer make to the premises and to all the several matters hereinbefore stated and charged, as fully and particularly as if the same were here repeated, and it especially interrogated as to

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each and every of said matters, and may be compelled to account for and pay to your orator the profits by it acquired, and the damages suffered by your orator from the aforesaid unlawful acts, and that the Court may assess said profits and damages, and may increase the damages to a sum not exceeding three times the amount thereof:--

May it please your Honors to grant unto your orator a writ of subpoena, issuing out of and under the seal of this Honorable Court, directed to the said defendant, American Graphophone Company, commanding it, by a certain day and under a certain penalty, to be and appear in this Honorable Court, then and there to answer to the premises, and to stand to and abide such order and decree as may be made against it.

And your orator will ever pray.

NATIONAL PHONOGRAPH COMPANY,

By W. E. Gilmore

President.

Richd N. Dyer.

Solicitor and of Counsel

for Complainant.

STATE OF NEW JERSEY, )
: ss.-
County of Essex, )

WILLIAM E. GILMORE, being duly sworn, deposes and says, that he is the president of the National Phonograph Company, the complainant named in the foregoing

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bill of complaint; that he has read the said bill and knows the contents thereof; that the same is true to his own knowledge save as to the matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true; that he verily believes Walter Henry Miller and Jonas Walter Aylsworth to be the first, original and joint inventors of the improved method of duplicating phonographic records set forth in said Letters Patent numbered 683,615, referred to in the said bill of complaint.

Subscribed and sworn to before me) William E. Gilmore
this 22nd day of October, 1903. )

Frank L. Dyer,

NOTARY PUBLIC, STATE OF NEW JERSEY,
COMMISSION EXPIRES FEBRUARY, 1908.

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No 1141

IN THE CIRCUIT COURT OF THE UNITED STATES

For the ..... District of Conn.

NATIONAL PHONOGRAPH COMPANY

*vs.*

AMERICAN GRAPHOPHONE COMPANY

In Equity, ~~Docket No. 1141~~

On M. & A. Pat. No. 683,615.

ANSWER.

PHILIP MAURO,

*for* DEFENDANT

277 BROADWAY, NEW YORK CITY.

~~To~~ ..... ~~Esq.~~,

~~Due and timely service of a copy of the within~~

is hereby admitted.

Dated, Jan 6. 1904

E. C. Mauro
Clerk

C. B. MERWIN PRINTER 218 FULTON ST., N. Y., TEL. 5487 CORT.

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UNITED STATES CIRCUIT COURT

DISTRICT OF CONNECTICUT

NATIONAL PHONOGRAPH COMPANY

v.

AMERICAN GRAPHOPHONE COMPANY

IN EQUITY
On Miller & Aylsworth's Patent
No. 683,615, Process.

ANSWER.

This defendant, now and at all times hereafter, saving and reserving unto itself any and all benefits and advantages of exception which can or may be had or taken to the many errors, uncertainties and other imperfections in the said complainant's bill of complaint contained, answering thereto or to so much and such parts thereof as it is advised it is material or necessary to make answer unto says:

That as to whether complainant is a corporation organized and existing under the laws of the State of New Jersey, with its principal place of business at Orange in said State, this defendant does not know and is not informed, save by the bill of complaint herein, and therefore calls upon complainant for proof thereof; but this defendant admits that it is a corporation organized and existing under the laws of the State of West Virginia, and that it has a regular and established place of business in the City of Bridgeport, State of Connecticut.

1. Defendant denies each and every allegation of paragraph 1 of the bill of complaint.

2. Defendant admits that U.S. Letters-patent No. 683,615 were issued to the National Phonograph Company on October 1,1901; but on information and belief denies the other allegations of paragraph II of the bill of complaint, defendant not being informed save by said bill.

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3. Not being informed save by the bill of complaint, defendant denies the allegations of paragraph III thereof.

4. Defendant denies the allegations of paragraphs IV and V of the bill of complaint; and, more specifically, defendant denies that it has in any way infringed, or has prepared or intends to infringe, the letters-patent in suit, and further denies that it has committed any acts whatsoever which would encourage and induce others to infringe the same.

5. Defendant avers on information and belief that Jonas Walter Aylswroth and Walter Henry Miller were the said ~~Xxxxxxx Xxxxxxxxxx~~ not the original, first and sole inventors or discoverers of the alleged invention or improvement set forth in U.S. Letters-patent No. 683,615, or any substantial or material part thereof; that the same and each and every substantial part thereof were, long prior to the said alleged invention, set forth in the following letters-patent and publications, namely:

Letters-patent of the United States:

| | | |
|---|---|---|
| No. 13,117, | June 19,1855, | Otis; |
| 33,884, | Dec. 10,1861, | Gwynne; |
| 37,898, | Mar. 17,1863, | Bonanzo; |
| 95,645, | Oct. 12,1869, | Brunner; |
| 108,306, | Oct. 11,1870, | Van Haagen; |
| 185,094, | Dec. 5, 1876, | Wilder; |
| 255,449, | Mar. 28,1882, | Pedrick; |
| 281,529, | July 17,1883, | Lefferts; |
| 303,970, | Aug. 26,1884, | Appelt; |
| 326,049, | Sept. 8,1885, | Muncaster; |
| 327,160, | Sept. 29,1885, | Hackman & Walter; |
| 334,786, | Jan. 26,1886, | La Bau; |
| 359,637, | Mar. 22,1887, | Schuberth; |
| 368,851, | Aug. 23,1887, | Philion; |
| 392,796, | Nov. 13,1888, | Hadley; |
| 400,649, | Apr. 2,1889, | Edison; |
| 408,998, | Aug. 13,1889, | Tattershall; |
| 414,761, | Nov. 12,1889, | Edison; |
| 437,429, | Sept. 30,1890, | Edison; |
| 445,932, | Feb. 3,1891, | Murnane & Drosten; |
| 466,728, | Jan. 5,1892, | Smith; |
| 484,582, | Oct. 18,1892, | Edison; |
| 493,191, | Mar. 7,1893, | Smith; |
| 525,116, | Aug.28,1894, | Richards; |
| 528,273, | Oct. 30,1894, | Lioret; |
| 563,572, | July 7,1896, | Day; |
| 573,564, | Dec.22,1896, | Ziegler-Reinacher; |
| 657,527, | Sept. 11,1900, | Edison; |
| 661,143, | Nov.6,1900, | Grasser; |



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Nos. 662,857, Nov. 27,1900, Hett;
662,858, Nov. 27,1900, Hett;
666,493, Jan.22,1901, Capps;
666,720, Feb. 5,1901, Edison;
666,819, Jan. 29,1901, Reynard;
666,937, Jan. 29,1901, Petit;
667,662, Feb. 5,1901, Edison;
682,991, Sept. 17,1901, Macdonald;
682,992, Sept. 17,1901, Macdonald;

Letters-patent of Great Britain:

No. 1478 of 1894, Young;

Publications as follows:

Knight's Mechanical Dictionary, Volume 2, 1880, pages 1461-1462;

Knight's Mechanical Dictionary, Volume 3, 1880, page 2169;

also many other letters-patent and publications as to the dates, numbers and description of which defendant is at present ignorant, but which it begs leave to disclose as soon as the same shall have been ascertained and to amend this answer by inserting the same allegations concerning such other letters-patent and publications as are hereinbefore made concerning those now known to this defendant as aforesaid.

6. This defendant avers, on information and belief, that the said Miller & Aylsworth were not the original, joint and first inventors or discoverers of the alleged invention or improvement set forth in said Letters-patent No. 683,615, or any material or substantial part thereof, and further avers that the said alleged invention or improvement, and each and every substantial and material part thereof, were, long prior to the said alleged invention either known or used by, or both known to and usedby the following persons at the places hereinafter named, to-wit:

Thomas A. Edison of Llewellyn Park, New Jersey;

Place of use: Llewellyn Park, New Jersey;

Frank L. Capps of Newark, New Jersey;

Place of use: Newark, New Jersey;



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James K. Reynard, of Newark, New Jersey;

Place of use: Newark, New Jersey;

Ademore N. Petit of Newark, New Jersey;

Place of use: Newark, New Jersey;

Thomas H. Macdonald of Bridgeport, Connecticut;

Place of use: Bridgeport, Connecticut.

7. This defendant avers, on information and belief, that the said letters-patent doesnot disclose or show any invention whatsoever in view of the state of the art of manufacturing sound records and analogous arts, as they existed at and long before the said Miller & Aylsworth ~~Thomas A. Edison~~ made the alleged improvement set forth in said letters-patent; and that, in view of the said state of the art, said alleged improvement was not patentable, and involved, if anything, mere mechanical skill.

8. This defendant further answering says, that by reason of amendments, disclaimers, and arguments filed during thependency ofthe application for said letters-patent, said letters-patent in suit is, if valid at all, restricted and limited in scope to a process which is not now and has not been employed by defendant.

9. Defendant avers, on information and belief, that for the purpose of deceiving the public the description and specification filed in the Patent Office in connection with the application for said letters-patent and now forming a part of the letters-patent itself, was made to contain less than the whole truth relative to the alleged invention or discovery, and that for this reason said letters-patent is null and void.

10. Defendant avers, on information and belief, that the process or alleged invention set forth in said letters-patent is inoperative and incapable of producing any useful result whatsoever.



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11. Defendant avers on information and belief that the alleged invention of said letters-patent No. 683,615 was abandoned to the public prior to the grant of the patent.

Wherefore, and for the causes aforesaid, this defendant wholly denies the equity of complainant's bill herein, and all manner of wrongful and unlawful acts wherewith in the said bill of complaint it is charged, and, further denies the right of the complainant to the relief, and each and every part thereof, alleged against this defendant in said bill of complaint, and submits it should not be compelled to make any other or further answer than that herein contained.

All of which matters and things this defendant is ready and willing to aver, maintain and prove as this Honorable Court shall direct; and said defendant prays the same benefits from this answer as if it had demurred to the said bill where a demurrer would have been proper, and pleaded to the said bill where a plea would have been proper, and humbly prays to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained.

American Graphophone Company.

by E. Easton

President.

Attest

C. A. Rockwell

Secy

(Seal)

Philip Mauros
C. A. L. Massies
Of Counsel

Philip Mauros
Sol. for Dept.
277 Broadway
New York City

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State of New York,)
:ss:
City of New York, )

Edward D. Easton, being duly sworn, deposes and says, that he is of lawful age, is a resident of New York City, and is President of the American Graphophone Company, the defendant named in the bill of complaint herein; that he has read the said answer subsfribed by him as President of the defendant Company and knows the contents thereof; except as to matters alleged to be stated on information that the same are true of his own knowledge/and belief, and as to those matters he believes it to be true.

Edward D. Easton

Subscribed and sworn to before me this 4th day of January, 1904.

(Seal)

Elisha Scamp
Notary Public, N.Y.C.

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NO. 1141.

UNITED STATES CIRCUIT COURT,

DISTRICT OF CONNECTICUT.

IN EQUITY.

NATIONAL PHONOGRAPH COMPANY

vs.

AMERICAN GRAPHOPHONE COMPANY.

ORDER.

Filed & Entered
June 26. 1905
E. E. Kanouse
Clerk

Richard N. Dyer,
Complainant's Solicitor,
31 Nassau St.,
New York City, N.Y.

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UNITED STATES CIRCUIT COURT,

DISTRICT OF CONNECTICUT.

| | |
|---|---|
| NATIONAL PHONOGRAPH COMPANY, Complainant, | |
| vs. | IN EQUITY, |
| AMERICAN GRAPHOPHONE COMPANY, Defendant. | NO. 1141. |

ORDER.

On motion of Richard N. Dyer, Esq., solicitor for complainant, and upon the consent of defendant's solicitor, it is

ORDERED that the above entitled action be and the same hereby is discontinued without prejudice and without costs to either party as against the other.

Dated, Hartford, Conn., June 16 1905.

By the Court
Attest:
E. E. Mann
~~U. S. C.~~
Clerk

We hereby consent to the entry and filing of the above order.

Richd N. Dyer
Solicitor for Complainant.

Philip Macrae
Solicitor for Defendant.

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